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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
Q137-US8

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Application Number
10/666,790Filed
September 17, 2003First Named Inventor
Hisashi Tsukamoto et al.Art Unit
1745Examiner
Dah Wei D. Yuan

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 42,491☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Signature

Travis Dodd
Typed or printed name818-833-2003
Telephone number09/5/2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

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This collection of information is required by 37 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Hisashi Tsukamoto

Serial No: 10/666,790

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY
CONSTRUCTION AND METHOD OF
MANUFACTURE

Art Unit: 1745

Examiner: YUAN, Dah Wei D.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

This communication is in response to the Office Action mailed on July 5, 2007 (the pending Office Action). Claims 55, 66-71, 85, 87, and 88 are rejected under 35 USC §103. All of the pending claims (55 and 66-88) are rejected for obviousness-type double patenting over the claims of U.S. Patent Application serial number 10/665,687. The Applicant submits that a clear legal error has been committed in the pending rejections of claims 55, and 66-88.

REMARKS

The Pending Claims

Claim 55 is the only independent claim pending in this application. Claim 55 is directed to an electric storage battery having a case sealed by a first end cap and a second end cap. The case, the first end cap, and the second end cap each exclude fill holes. An electrically conductive terminal pin extends through the first end cap.

Rejection of Claim 55 Under 35 USC §103

Claim 55 stands rejected under 35 USC §103(e) as being unpatentable over U.S. Patent Application No. 2002/0001745 A1 (Gartstein) in view of U.S. Patent No. 6,378,561B1 (Nemoto). Claim 55 recites an electrode assembly that includes an electrode in electrical communication with a terminal pin that "extend(s) through (a) first end cap." The Office Action argues that it would be obvious to modify the battery of Garstein with the external terminal of Nemoto. However, this modification does not result in the claimed invention.

In supporting of the rejection, the Office Action cites C11, L58-C12, L18 of Nemoto. However, a section of this same citations states the following:

It goes without saying that the external terminal 13 is a member to be disposed **outside** the battery 10 to extract the current of the battery outward In the case where the caps 21 and 22 to be used are made of a metal, ... the **external terminal 13 are firmly attached** to the caps 21 and 22 by means of welding, etc... (C12, L10-12 with emphasis added)

Since Nemoto teaches that the external terminal 13 is positioned outside of the battery, then the external terminal does not extend through an end cap as this would result in a portion of the external terminal being positioned inside the battery.

Additionally, the supporting text (C11, L58-C12, L18) is associated with Figure 1 of Nemoto. Figure 1 also teaches that the external terminal 13 does not extend through an end cap. For instance, the labels 98 and 99 in Figure 1 do not represent an extension of the external terminal 13 into the battery. Nemoto's text explains these labels as follows:

the internal terminals 14 and the tabs 5 connected to the internal terminals 14 ... are preferably installed ... in a remote position from the regions..., **namely, the region 98** which covers from the electrolyte solution injection opening 11 to the upper end of the core 6 **and the region 99** which covers from the lower end of the core 6 to the cap 22 at the bottom part of the battery 10 (emphasis added). (C15, L67- C16, L7 with emphasis added).

As a result, the labels 98 and 99 merely label regions within the battery and do not indicate physical components. Accordingly, these labels do not suggest a physical extension of the external terminal 13 into the battery.

The dashed lines labeled 11 in Figure 1 also do not represent an extension of an external terminal 13. For instance, C12, L30-33 provide that the "opening 11 is disposed ... in the cap 21." As a result, the dashed lines represent an opening in the cap 21. Nemoto also teaches that the external terminal 13 does not extend into the opening 11. For instance, C4, L13-15 provides that "one may seal the ... opening 11 by filling sealing materials such as resin." Since a sealing material is positioned in the opening 11, the external terminal 13 does not extend into the opening 11. As a result, the dashed lines labeled 11 in Figure 1 also do not represent an extension of an external terminal 13 into the cap.

Since Nemoto teaches that the external terminal 13 is attached to a cap and is positioned outside of the battery, modifying Garstein's battery with Nemoto's external

terminal results in Garstein's battery having a terminal attached to the outside of Garstein's cap 16. An external terminal attached to the outside of a cap does not result in a "terminal pin extending through the first end cap" as is claimed. As a result, the modification Garstien set forth in the Office Action does not result in the claimed battery.

Double patenting rejection

All of the pending claims are also rejected for double patenting in view of the claims pending in US Patent Application serial number 10/665,687 (the '687 application). However, there is likely no need to consider the merit of the double patenting rejection. The '687 application has not issued, was co-owned with this application at the time of invention, and has a different inventive entity. Under these circumstances, the double patenting rejection is a **provisional** double patenting rejection as set forth in chart I-B of MPEP §804 and MPEP 804(I)(B).

Because the Applicant has overcome the obviousness rejection, the provisional double patenting rejection is the only pending rejection in the application and accordingly, the first or second paragraph of MPEP §804(I)(B)(1) applies. The first paragraph indicates that this applications should be allowed if a double patenting rejection is not the only pending rejection in the '687 application and this application is the earlier filed application. The second paragraph indicates that this applications should be allowed if a double patenting rejection is the only pending rejection in the '687 application and this application is the "base" application. As a result, the applicable paragraph depends on what rejections are pending in the '687 application. In the '687 application, the Applicant responded to an Office Action on 6/26/07. As a result, at the time of this writing, the identity of the correct paragraph of MPEP §804(I)(B)(1) is unclear but should be determined at the time of review in order to bring this application into compliance with the correct paragraph of MPEP §804(I)(B)(1). Further, if the conditions in the identified paragraph of MPEP §804(I)(B)(1) are satisfied, the provisional double-patenting rejection need not be considered and this application should be allowed.

Even if the merit of the double patenting rejection is considered, the record does not support the double patenting rejection. The Office Action reasons that "they are not

patentably distinct from each other because the conflicting claims in the examined application claim fall entirely within the scope of the co-pending 10/655,687 Application.”

MPEP 804 explicitly addresses this reasoning and provides the following:

Domination and double patenting should not be confused.... One patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection....

In view of the domination definition set forth above, the Office Action argues that there is double patenting because the claims in the ‘687 Application dominate the immediate claims. Since “domination by itself ... cannot support a double patenting rejection,” and the domination argument is the only argument that the Office Action sets forth to support the double patenting rejection, the double patenting rejection relies on improper reasoning and should be withdrawn.

Additionally, the Applicant has previously argued that the restriction requirement is impermissible because the allegedly conflicting claims are included divisional applications filed in response to a restriction requirement mailed on June 3, 2003 in U.S. Patent Application Serial No. 10/167,688 (parent), filed June 12, 2002. Despite this argument, the double patenting rejection was maintained on the grounds that the allegedly conflicting claims in the pending applications are not consonant with the claims pending at the time of the restriction requirement. MPEP804.01(b) defines what is meant by the requirement of consonance when it states that “In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained.” The lines of demarcation cited in the original Restriction Requirement are still present.

The Restriction Requirement provides the following reasoning for restriction between the pending claims and the claims of the ‘687 Application:

This application contains claims directed to the following **patentably distinct** species of the claimed invention.... I-3, Claims 43-46, drawn to an electric storage battery comprising a flexible conductive tab.... I-5, Claim 55, drawn to an electric storage battery having an

electrically conductive case hermetically sealed by first and second end caps have no separate fill holes (sic).

Because the claims in the pending Applications still contain the same limitations used to support the above restriction, the lines of demarcation employed in the Restriction Requirement are still present. In fact, the statements made in support of the restriction requirement still apply to the pending claims.

Additionally, Applicant notes that the original claim 44 filed in the parent application recited that "said case has no separate fill hole" and the original claim 55 recited "a flexible conductive tab electrically coupled to said second electrode and to said second end cap." Because these limitations were present when the original Restriction Requirement was made, the Office Action should not be relying on the continued presence of these limitations to support the double-patenting rejection. As a result, the prohibition against double patenting of restricted claims applies and the double patenting rejection should be withdrawn.

Conclusion

The Applicant respectfully submits that legal error has been made by rejecting the pending claims for obviousness and obviousness-type double patenting. For these reasons, allowance of claims 55 and 66-88 is respectfully requested.

Respectfully submitted



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